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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|----------------------|------------------|
| 10/748,669 | 12/31/2003 | Donald C. Wood | CLEV:629 | 2780 |
| 6160 | 7590 | 02/11/2005 | EXAMINER | |
| PARKHURST & WENDEL, L.L.P. 1421 PRINCE STREET SUITE 210 ALEXANDRIA, VA 22314-2805 | | | BLAU, STEPHEN LUTHER | |
| | | ART UNIT | PAPER NUMBER | |
| | | 3711 | | |

DATE MAILED: 02/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|-----------------|--------------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 10/748,669 | WOOD ET AL. <i>CB</i> | |
| | Examiner | Art Unit | |
| | Stephen L. Blau | 3711 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 20 December 2004.
 2a) This action is FINAL. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-9 is/are pending in the application.
 4a) Of the above claim(s) 2 and 7-9 is/are withdrawn from consideration.
 5) Claim(s) _____ is/are allowed.
 6) Claim(s) 1 and 3-6 is/are rejected.
 7) Claim(s) _____ is/are objected to.
 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Claims 2 and 7-9 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 20 December 2004. The argument that search of the entire examination could be made without serious burden to the examiner is disagreed with. There are clubs with spherical heads which are not used as a method to fit a length of a club to a player. As such different searches would have to be made. In addition, there is not one subclass that contains spherical heads as such different searches would have to be made for both the embodiments and their different structures. As such the restriction is proper and stands.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent

granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claim 1 rejected under 35 U.S.C. 102(b) as being anticipated by Nakajima, or Novosel.

Nakajima (Figs. 1-2) or Novosel (Figs. 1, 4) disclose a spherical ball having a hosel bore therein, a shaft in a hosel bore, a grip at the end of a shaft, and club able to perform the function of fitting a desired length for an iron to an individual player in the form of one skilled in the art able to observe how this club with its length fits to a player and giving appropriate recommendations to a player.

In an apparatus claim weight is give to what an apparatus is and not how it is used or made. These clubs are able to perform the claimed function.

4. Claims 1 and 5-6 are rejected under 35 U.S.C. 102(e) as being anticipated by Flood.

Flood discloses a spherical ball have a hosel bore therein, a shaft in a hosel bore, a grip at the end of a shaft (Fig. 4), a club having a length of about 37 ½ inches in the form of shaft portion (36) being about 34 inches and the terminal portion (40) being about 2 to about 5 inches (Fig. 4, Col. 2, Lns. 58-67), a kit in the form of the parts being separated (Fig. 5) and a club able to perform the function of fitting a desired length for an iron to an individual player in the form of one skilled in the art able to observe how this club with its length fits to a player and giving appropriate recommendations to a player.

In an apparatus claim weight is give to what an apparatus is and not how it is used or made. This club is able to perform the claimed function.

5. Claims 1 and 3 are rejected under 35 U.S.C. 102(b) as being anticipated by Witherspoon.

Witherspoon discloses a spherical ball having a hosel bore therein with the hosel portion extending (17) radially from a ball and the hosel bore being in the extending hosel portion (Fig. 2), a shaft in a hosel bore (Fig. 2), a grip at the end of a shaft (Fig. 1), and a club able to perform the function of fitting a desired length for an iron to an individual player in the form of one skilled in the art able to observe how this club with its length fits to a player and giving appropriate recommendations to a player.

In an apparatus claim weight is give to what an apparatus is and not how it is used or made. This club is able to perform the claimed function.

6. Claims 1, 4 and 6 are rejected under 35 U.S.C. 102(e) as being anticipated by Yim.

Yim disclose a spherical ball have a hosel bore therein (Fig. 1), a shaft in a hosel bore, a grip at the end of a shaft (Fig. 3), an exterior surface of a spherical ball comprising a flat surface parallel to an axis of a hosel bore (Abstract, Fig. 1), a kit in the form of the parts being separated (Fig. 5) and a club able to perform the function of fitting a desired length for an iron to an individual player in the form of one skilled in the

art able to observe how this club with its length fits to a player and giving appropriate recommendations to a player.

In an apparatus claim weight is give to what an apparatus is and not how it is used or made. This club is able to perform the claimed function.

7. Claims 1 and 6 are rejected under 35 U.S.C. 102(b) as being anticipated by Liotta.

Liotta (Figs. 1, 4) disclose a spherical ball having a hosel bore therein, a shaft in a hosel bore, a grip at the end of a shaft, a kit in the form of the parts being separated (Col. 2, Lns. 14-26) and club able to perform the function of fitting a desired length for an iron to an individual player in the form of one skilled in the art able to observe how this club with its length fits to a player and giving appropriate recommendations to a player.

In an apparatus claim weight is give to what an apparatus is and not how it is used or made. This club is able to perform the claimed function.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Rango, Kinney, Coleman, and Carlino discloses spherical head clubs.

Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steve Blau whose telephone number is (571) 272-4406. The examiner is available Monday through Friday from 8 a.m. to 4:30 p.m.. If the examiner is unavailable you can contact his supervisor Greg Vidovich whose telephone number is (571) 272-4415. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0858. (TC 3700 Official Fax 703-872-9306)

slb/ 8 February 2005



STEPHEN BLAU
PRIMARY EXAMINER